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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,321	09/08/2000	Gerhard J. Mueller	GK-ZEI-3103/ 500343.20100	3537

7590 03/26/2003  
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New York, NY 10022-7650

EXAMINER

NGUYEN, THONG Q

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 03/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Notice of Abandonment**

Application No.

09/658,321

Examiner

Thong Q. Nguyen

Applicant(s)

MUELLER ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 29 January 2002.
  - (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.  
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c) ☒ A reply was received on 7/23/02; 12/10/02 but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d) ☐ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b) ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☒ The reason(s) below:

See attached sheets

Thong Q. Nguyen  
Primary Examiner  
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Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

## **DETAILED ACTION**

### ***Response to Amendment***

1. The present office action is made in response to the amendments (Paper Nos. 17, 19 and 20) filed on 7/23/02; 12/10/02 and 12/11/02.

It is noted that in the mentioned amendments, applicant has 1) amended claims 16, 18-19, 24-25, 28 and 31; 2) canceled claim 17; and 3) added new claims 32-34 into the application.

### ***Election/Restrictions***

2. The amended claims are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The present application was subjected to a restriction requirement (see Paper No. 7 of 8/7/2001). In response to the restriction requirement applicant elected the species shown in figure 2 (Paper No. 9 of 11/7/01). The application with the elected species shown in figure 2 which includes claims 16-20, 23-26, 28 and 31 was examined and an Office action was mailed to applicant on 1/29/02 (Paper No. 11).

In response to the mentioned Office action, applicant has filed a set of amendments (Paper Nos. 17, 19 and 20) in which applicant has amended claims 16, 18-19, 24-25, 28 and 31, and added new claim 34. After carefully review the subject matter recited in amended claims and the newly-added claim, the following conclusions have been made.

- 1) The amendment to claim 16 bring material disclosed in the non-elected species into the claim; (Note: The support for this conclusion is found in the present

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specification which details are provided below) thus, the claims 16 and 18-33 are not examined in this Office action because applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16 and 18-33 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

It is also noted that applicant's request/arguments regarding to the subject matters added to the original claim 16 have been fully considered but they are not persuasive.

2) Newly-added claim 34 contain subject matter regard to the use of reflector and its position in the system which features are similar to the features recited in amended claim 16, thus this claim is also grouped into the non-elected species shown in figure 1.

Note: The materials which are newly-added to claim 16 and the features recited in new claim 34 make the device recited in each claim now directs to the none-elected species shown in figure 1.

The use of mirror in the pupil plane of the object is disclosed in the embodiment1 disclosed in the specification in pages 6-7 and shown in figure 1. The amended claim 16 and new claim 34 is not directed to the elected species shown in figure 2 described in the specification in pages 7-8. Applicant is respectfully invited to review the specification at pages 6-8 and fig. 1 in which they disclose the use of two mirrors (12 and 5) at the pupil plane of the objectives (2 and 3). The embodiment described in specification in pages 7-8 and shown in figure 2 disclose the use of only one mirror (23) at a focal plane

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of the objective lens (23). There is not any reflector in the pupil plane of either objective lens (20 or 21).

3) With regard to the applicant's arguments as provided in the amendment of 12/11/02, the examiner offers the following opinions.

With regard to the features thereof "wherein a transmitted excitation... phase front" recited on last three lines of claim 16, such a feature is considered as a new matter to the invention because the specification as originally filed does not disclose any embodiment having such a recitation as set forth in the mentioned features. Applicant should note that the use of reflector (12) in the embodiment shown in figure 1 is for the purpose of transmittance illuminating light but reflectance fluorescent light back onto the specimen (see specification, page 7, lines 22-25). The use of excitation filter (7), barrier (or blocking) filter (10) and dichroic beam-splitter in the illuminating path provided by light source (6) is for the purpose of exciting fluorescent agent in the sample wherein the light source (6). In the embodiment described in pages 7-8 and shown in figure 2, the following features are disclosed: 1) there is only one mirror (23) disclosed at the focal plane of the objective (21); 2) laser is used; 3) there is not any excitation and blocking filters be used in the illuminating system and there is not any description regarding the structure of the beam-splitter (18).

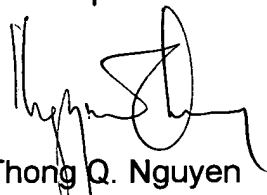
### ***Conclusion***

3) Since the time to response to the Office action (Paper NO. 10) mailed to applicant on 1/29/2002 has expired, thus the application is now abandoned.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (703) 308-4814. The examiner can normally be reached on M-F.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen  
Primary Examiner  
Art Unit 2872

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March 10, 2003